

Application No.: 09/858,035

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REMARKS/ARGUMENTS

Claims 41-56 are pending in the present application. By virtue of this response, claims 48 and 50 have been amended and claims 51-56 have been added. Support for the new claims can be found on p. 13, line 15 through p. 14, line 21 of the specification and in Figures 5-12 of the drawings. Amendment of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. The specification has been amended as requested by the Examiner to include the exact language present in the claims. No new matter has been added.

Applicants acknowledge the Examiner's notation regarding a potential interference with USPN 6,364,904 being declared. With respect to the double patenting rejection, Applicants intend to file a terminal disclaimer upon the indication of allowable subject matter.

Rejections under 35 U.S.C. § 112

Claims 45, 47, 48, and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. These claims are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse these rejections.

With respect to claim 45, as the Examiner notes, the claimed material "spring metal alloys" is supported by originally filed claim 2. Original claim 2 is reprinted below (emphasis added):

2. The endoluminal prosthesis according to Claim 1, wherein the elastically deformable and elastically recoverable material of the wire member is selected from the group of materials consisting of shape memory alloys, biocompatible spring steels, biocompatible spring metal alloys, and carbon fibers.

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Thus, of the group of materials listed in original claim 2, which includes "spring metal alloys," each is a possible material for the wire member. Likewise, in pending claim 45, the identical group of materials is listed as a possible material for the "wire member." It is therefore clear that support for the objected to material was present in the application as filed. Moreover, the term "spring metal alloys" is clearly supported by the specification, for example, on p. 4, lines 4-5 ("The present invention employs a wire member made of either a shape memory alloy..., spring stainless steel or other elastic metal..."). Since "spring stainless steel" is a "spring metal alloy" the claimed term is necessarily supported in the specification. However, to satisfy the Examiner's requirement, the specification has been amended to give exact antecedent support.

With respect to claims 47 and 48, the specification clearly supports an inner and outer tubular substrate (see p. 11, lines 4-17, describing Figs. 2-3).

With respect to claim 50, although believing that one of ordinary skill in the art would understand what is claimed in using the term "generally" as applied to quadrilateral cross-sectional shapes, especially in view of the discussion with respect to Figure 6 on page 13, lines 19-21, Applicants have nevertheless amended claim 50 to remove the relative term.

Therefore, in view of the above, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §112.

Rejections under 35 U.S.C. § 102

Claims 41, 42, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Pinchuk et al (USPN 5,968,091). Applicants respectfully traverse this rejection.

The Examiner states that the claim language is anticipated by Pinchuk et al. and cites to Fig. 7 and col. 5: 40-55 and col. 2: 55-col. 3:2 for support. The citations provided by the Examiner describe a balloon expandable stent having a zig-zag configuration where adjacent zig-zags (e.g., 34, 36) touch each other. The stent is sprayed with polycarbonate urethane dissolved in dimethylacetamide at a particular concentration. The stent is dried and is sprayed and dried another

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five times. Thus, as the abstract notes, Pinchuk et al. describes a coated balloon expandable stent such that the coating binds adjacent zig-zags without occluding the interstices of the stent lattice.

The rule for anticipation under §102 is that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (MPEP 2131). Claim 41 recites "an endoluminal prosthesis, comprising an elongate support wire member joined to a polymer cladding, the joined support wire member and polymer cladding being helically wrapped into an open cylindrical structure such that adjacent windings of the polymer cladding have overlapping regions that are bonded to one another." Pinchuk et al. does not disclose at least three required limitations of claim 41.

First, Pinchuk et al. does not disclose a polymer cladding. The term polymer cladding is defined in the specification as being a polymeric material that is at least partially surrounding the wire member (see p. 4, lines 26-30). In one example, the polymer cladding is disclosed as being "co-extruded with the support wire member 14" (p. 10, lines 24-25). Certainly, the coating of Pinchuk et al. cannot be fairly interpreted as a polymer cladding as defined in the present invention. Further, Pinchuk et al. does not disclose the limitation of the joined support wire member and polymer cladding together being helically wrapped into an open cylindrical structure. At most, Pinchuk et al. discloses only a wire member being helically wrapped. Finally, it is without question that Pinchuk et al. does not disclose that adjacent windings of the polymer cladding have overlapping regions that are bonded to one another. Pinchuk et al. discloses only a repeated spraying and drying process of applying a coating to a stent. Thus, Applicants submit that Pinchuk et al. does not anticipate claim 41, or claims 42 and 44, dependent thereon.

Therefore, in view of the above, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §102.

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Rejections under 35 U.S.C. § 103Pinchuk et al. in view of Dotter

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchuk et al (USPN 5,968,091) in view of Dotter (USPN 4,503,569). Applicants respectfully traverse this rejection.

With reference to the above discussion, Pinchuk et al. does not disclose several limitations required by claim 41. Moreover, it would not be obvious to one of ordinary skill in the art to join a wire member to a polymer cladding and wrap the joined support wire member and polymer cladding helically into an open cylindrical structure such that adjacent windings of the polymer cladding have overlapping regions that are bonded to one another in view of the Pinchuk et al. teaching of spray-coating a stent. Dotter, which is directed to a helically wound coil having a generally tubular shape made of a shape memory Nitinol alloy having a transition temperature in the range of 115°-125° F., does not cure the deficiencies of Pinchuk et al. Therefore, Applicants submit that claim 46, which is dependent on claim 41, is not rendered obvious by a combination of Pinchuk et al. and Dotter.

Pinchuk et al. in view of Lee

Claims 47-50 are rejected over 35 U.S.C. 103(a) as being unpatentable over Pinchuk et al (USPN 5,968,091) in view of Lee (USPN 5,123,917).

With reference to the above, Pinchuk et al. does not disclose, teach or suggest the present invention as claimed in claim 41. Lee, which is directed to a flexible cylindrical inner tube having a outer periphery and a plurality of separate scaffold member mounted on the outer periphery of the inner tube and a flexible cylindrical outer tube concentrically enclosing the inner tube and the plurality of scaffold members mounted thereon, does not cure the deficiencies of Pinchuk et al. Therefore, Applicants submit that claims 47-50, which are ultimately dependent on claim 41, are not rendered obvious by a combination of Pinchuk et al. and Lee.

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Therefore, in view of the above, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103.

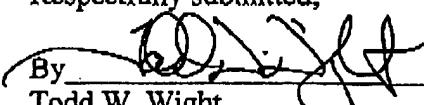
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 297912001911. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: September 25, 2003

Respectfully submitted,

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